Intellectual Property

In Living Color

By Glenn Dickinson

Trademarks, traditionally, consist of a name or image. Back when virtually all advertising was done in paper, the trademark had to be static and reproducible on the two-dimensional surface of a newspaper advertisement or product package. Radio and television introduced the world to the idea of sounds and moving pictures as source indicators. The proliferation of the Internet and handheld digital devices represents a shifting of the balance of marketing power away from the static media, and toward a video- and audio-rich environment. In this world, sounds and moving images have a much greater potential value as source indicators.

Nontraditional trademarks have occupied a fairly arcane niche in the trademark world. The Supreme Court decision in *Qualitex Co. v. Jacobson Products Co.*, Inc., 514 U.S. 159 (1995), did not announce so much as acknowledge the legitimacy of these marks. In that case, the manufacturer of press pads used in dry cleaning and laundry establishments filed a trademark infringement action against a competitor, alleging trademark infringement and unfair competition. The Supreme Court held that: (1) no special legal rule prevents color alone from serving as a trademark; and (2) the green-gold color of the manufacturer's dry cleaning press pads could be registered as trademark. "It is the source-distinguishing ability of a mark — not its ontological status as color, shape, fragrance, word, or sign — that permits it to serve these basic purposes."

Pocket-sized audio and video devices greatly increase the potential impact of marks that don't employ the written word. Understanding the obstacles and opportunities in the cyber millennium, however, depends on a knowledge of more mundane types of nontraditional trademarks, such as colors, scents and flavors.

Color has successfully served as a source indicator for a number of products and services. The Trademark Office takes the position that color cannot be inherently distinctive, so trademark protection depends on the establishment of secondary meaning. This has been possible for the color pink, to indicate the source of insulation manufactured by Owens-Corning and the color brown to indicate the source of transportation and delivery services offered by United Parcel Service. It should be noted that in both these examples, the trademark registrations do not cover the color in the abstract, but as applied to specifically identified items, such as trucks, uniforms and insulation.

These older applications use the Trademark Office's former regime of indicating color by means of lines. Applications filed after Nov. 2, 2003, require an actual image of the color concerned. Applicants may employ a description of the mark that refers to the PANTONE color system long used in the graphic arts community.

Many creative trademark applicants have tried their hands at registering flavors and scents, but with mixed success. The primary difficulty with these qualities is the problem of functionality. Trademark law does not allow one person to appropriate the qualities of a product that comprise or perform the function of the product. One function of flavored and scented things is to taste and smell a certain way, such as a candle that exudes the fragrance of "combusted nitro methane racing fuel" in one unsuccessful application. An often-cited example of a flavor mark, and perhaps the only flavor application in the U.S. Trademark Office, is the unsuccessful application to register the flavor of orange for pharmaceutical products.

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The chances of success appear to increase when the applicant arbitrarily associates a scent with a product or service that is not intended to affect the smell of things, such as lubricants and motor fuels with a cherry scent. Nonetheless, the applicant for a scent mark faces a heightened evidentiary standard in the Trademark Office.

Tactile trademark rights exist, but not on their own. No one owns a texture such as "soft" or "slimy" as a quality in itself. Tactility is an aspect of trade dress and, as such, functions as a source indicator in the form of, for example, a velvet-textured covering on the surface of a bottle of wine.

Both audio and visual marks have been around for a long time. The National Broadcasting Company's distinctive chimes were registered in 1971, representing an early recognition of the evolution of trademark significance in the new electronic media.

Moving visual images made a surprisingly early debut, in the form of a mark consisting of "the audio and visual representation of a coin spinning on a hard surface, used in TV advertising." This registration was issued in 1957 to a forward-thinking Minnesota bank, which discontinued use of the mark in the 1980s. Another audiovisual mark which debuted in 1924, and won trademark registration in 1986, consists of a roaring lion, to indicate the source of motion pictures and entertainment services.

In the past few years, sound marks have expanded with extraordinary rapidity. Many of these relate to computers and the Internet, and they take a variety of forms. Marks consisting of complete musical compositions have been with us for generations, although some have only recently achieved trademark status, such as the whistled version of a ragtime standard that was first used in 1948 in association with basketball entertainment but was registered in 1992, and the operatic overture that was famously transported to the American West in 1933 but registered in 1998. For another famous sound mark, the applicant chose only a few bars from the rollicking orchestral theme to identify the source of humorous cartoons for children, among other entertainment services.

Marks of this type raise challenges both for the drafter attempting to craft a description, and the trademark practitioner attempting to search the trademark databases. Nontraditional marks can be found if one searches for "6" as the value of the Mark Drawing Code. Having found the registration, a musically inclined attorney reading the description, "A five tone audio progression of the notes D Flat, D Flat, G, D Flat and A Flat," might be able to reach for the office ukulele and plunk out what is immediately recognizable as the jingle associated with a certain famous computer microprocessor. But what about the rest of us? The trademark firm handling these applications on a regular basis might well need a composer in residence.

A useful innovation at the Trademark Office might be the introduction of standard musical notation and nomenclature to trademark descriptions. Even a world-renowned maestro, however, will puzzle over how to describe some sound marks. For instance, try closing your eyes and playing back in your memory this familiar trademark: "30 voices over seven measures, starting in a narrow range, 200 to 400 [hertz], and slowly diverting to preselected itches [sic, should be "pitches"] encompassing three octaves. The 30 voices begin at pitches between 200 Hz and 400 Hz and arrive at pre-selected pitches spanning three octaves by the fourth measure." If you're not singing along yet, then it might help to recall that this is the description of the mark that identifies THX Ltd. as the source of entertainment services.

Less-complex sounds can be found in the repertoire of audio trademarks, such as a ringing bell to identify a securities exchange and related stock market services, the spoken phrase "You've Got Mail" to identify a provider of computer network access and a doughnut-craving cartoon character's trademark phrase (well, almost trademarked) "D'oh!"

Having appreciated instrumental music and the spoken word, we can take in a variety of singing performances, from classics such as the "Ho, Ho, Ho" signifying the source of canned vegetables, to a bluegrass-style yodel, identifying an Internet search engine. Then there are those trademarked vocalizations that defy genres, such as the compelling call of the jungle's enduring human hero.

The ability to digitally record natural sounds has created industries that a short time ago would have seemed ridiculous. The online provision of cell phone ringtones surely tops the list of commercial enterprises that no futurist ever foresaw. Given the wild popularity and concomitant commercial potential of these sounds, it is mildly surprising that so few have achieved trademark status. One of a few in this select group is the sound of a human child giggling. Others have generated opposition proceedings that are still pending, including an electronic chirp consisting of a repeated tone played at 911 Hertz . That particular opposition has potentially far-reaching effects. Nextel Communications is challenging the application of Motorola to register the electronic chirp cited above on the ground that the ringtone is primarily functional: It signals some event relating to the function of the device. The Trademark Trial & Appeal Board proceeding in this matter (Opposition No. 91161817) could sound the death knell for the ringtone trademark.

Sound marks have increased, but there has been no apparent jump in the number of video trademarks. The reasons for this are not immediately clear. A series of moving images seem just as likely to perform a source-identifying function as a sound. The video trademark might still be over the horizon.

For both the presently registered audio trademarks and the video trademarks of the future, the patent office needs to provide a way to hear and view the specimens on a personal computer. The technology is available: The Trademark Office has a delightful sampling of sound marks, which can be found at www.uspto.gov/go/kids/kidsound.html. This resource is not meant to assist the high-paid and hard-pressed trademark practitioner; it's found within the kids' pages, where the lawyers of tomorrow can toy with the lighter side of trademark law. But it will help the interested reader identify some of the sounds and tunes cited in this article.

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